The opinion in support of the decision being entered today is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHAD ROBERTS, TROY W. ROBERTS,
and OWEN C. STENSETH

Appeal 2007-1881
Application 10/092,259
Technology Center 2100

Decided: August 14, 2007

Before ANITA PELLMAN GROSS, LANCE LEONARD BARRY,
and ST. JOHN COURTENAY, III, *Administrative Patent Judges*.

GROSS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Chad Roberts, Troy W. Roberts, and Owen C. Stenseth (Appellants) appeal under 35 U.S.C. § 134 from the Examiner's Final Rejection of claims 1 through 19, which are all of the claims pending in this application.

Appellants' invention relates to a method and system for configuring handheld devices (Specification, paragraphs [0001]-[0003]). Claims 1 and 19 are illustrative of the claimed invention, and they read as follows:

1. A system for configuring handheld devices, comprising:

a website engine, for receiving user input;

a build-to-order configuration engine for communicating with developers, coordinating software licensing, arranging software downloads and preventing conflicts;

a database engine, for managing executable code and data responsive to said configuration engine, and

a loading station for performing the actual downloads;

wherein said loading station loads said handheld device based on user input received through said website engine and conveyed to said data base and build-to-order configuration engines.

19. A method of loading software onto a handheld device, comprising:

querying a build-to-order configuration engine to ensure sufficient memory is available to accommodate said software, that the desired software has no conflicts with any other software desired by said user, and that the handheld device O/S (Operating System) can accommodate said software;

querying said handheld device to ensure sufficient memory is available, and reporting an error back to said user if necessary;

if necessary, prompting a user to order additional memory such as on a memory card; and

locating said software program on said memory card where possible.

The prior art reference of record relied upon by the Examiner in rejecting the appealed claims is:

Mitchelmore	US 2002/0090934 A1	Jul. 11, 2002 (filed Nov. 20, 2001)

Claims 1 through 19 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Mitchelmore.

We refer to the Examiner's Answer (mailed November 16, 2006) and to Appellants' Brief (filed February 24, 2006) and Reply Brief (filed December 13, 2006) for the respective arguments.

SUMMARY OF DECISION

As a consequence of our review, we will reverse the anticipation rejection of claims 1 through 19.

OPINION

Appellants contend (Br. 4-7) that Mitchelmore fails to disclose a "build-to-order configuration engine for communicating with developers, coordinating software licensing, arranging software downloads and preventing conflicts," as recited in independent claim 1. The Examiner asserts (Answer 3) that Mitchelmore discloses the claimed "build-to-order configuration engine" in paragraphs 8, 14, 17-19, 58, 65, 100, 102, 103, 178, 181, and 183. The first issue, therefore, is whether Mitchelmore discloses a build-to-order configuration engine for communicating with developers, coordinating software licensing, arranging software downloads, and preventing conflicts.

Mitchelmore (paragraph [0085]) discloses that web management subsystem 625 forms content requests and coordinates receipt of requested content. Web management subsystem 625 may include a subscription manager which allows users to keep track of current channel subscriptions (paragraphs [0099]-[0100]). Details of software desired by the user are sent to the subscription manager, and the subscription manager "may request application files directly from the application developer's server" (paragraphs [0179]-[0181]). Thus, Mitchelmore discloses communicating with developers and arranging software downloads. Further, Mitchelmore discloses (paragraph [0122]) that when a user wishes to install software on a handheld device, the application is registered with an application manager. Thus, Mitchelmore discloses coordinating software licensing. However, we find nothing in the paragraphs cited by the Examiner or elsewhere in Mitchelmore about a build-to-order configuration engine or about preventing conflicts. Since Mitchelmore fails to disclose each and every limitation of independent claim 1, we cannot sustain the anticipation rejection of claim 1 or its dependents, claims 2 through 18.

Regarding claim 19, Appellants contend (Br. 9-10) that Mitchelmore fails to disclose querying how much memory is available in the handheld device, querying whether the operating system can accommodate the software, or reporting to the user that the additional memory is needed when the device has insufficient memory. The Examiner cites paragraphs 5, 18, 19, 100, 178, and 181-183 as teaching the steps of claim 19. The second issue, therefore, is whether Mitchelmore discloses querying how much memory is available, querying whether the operating system can

accommodate the software, and reporting the user that additional memory is needed.

We have reviewed Mitchelmore, paying particular attention to the paragraphs cited by the Examiner, and the only teaching we found regarding memory appears in paragraph [0190]. Specifically, Mitchelmore discloses that the user may add components to provide personal configuration management which may enable the user to swap applications in and out of the handheld device to release limited storage resources. Although this paragraph suggests managing the memory of the handheld device, it falls short of teaching querying how much memory is available and reporting to the user that additional memory is needed. Also, we find no teaching of querying whether the operating system can accommodate the software. Therefore, we cannot sustain the anticipation rejection of claim 19.

ORDER

The decision of the Examiner rejecting claims 1 through 19 under 35 U.S.C. § 102(e) is reversed.

REVERSED

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